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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,102	06/20/2000	Christopher Graham Raphael Parsons	MERZ30 / din	6038

25666 7590 03/19/2003
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KALAMAZOO, MI 49007

EXAMINER

JIANG, SHAOJIA A 15

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/597,102	Applicant(s) PARSONS ET AL.	
	Examiner Shaojia A. Jiang	Art Unit 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.


Claim(s) rejected: 1-17.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).

10. ☐ Other: _____


 SREENI PADMANABHAN
 PRIMARY EXAMINER

3/12/05

Advisory Action

This Office Action is a response to Applicant's amendment and response after FINAL filed on September 10, 2002 (a copy by Fax filed on March 3, 2003).

2. Applicant's proposed amended claim, deleting "anxiety disorders, schizophrenia, drug and alcohol abuse disorders, depressive disorders, cognitive disorders, Alzheimer's disease" and "Parkinson's disease, Tourette's pain" from the original claim, are not deemed to place the application in better form for appeals by materially reducing or simplifying the issues for appeal, as discussed further below.

5. Applicant's remarks filed on September 10, 2002 with respect to the rejection of claims 1-17 made under 35 U.S.C. 102(e) as being anticipated by Gold et al. (WO 99/01416) have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated June 5, 2002.

As discussed in the Final Rejection, Gold et al. disclose that the same 1-aminoalkylcyclohexanes as herein are useful in the treatment of CNS disorders or a living animal for alleviation of a condition which is alleviated by the NMDA receptor antagonists. The instant claims 1-17 are drawn to a method of treating a living animal for inhibition of progression or alleviation of a condition which is alleviated by a 5HT3 or neuronal nicotinic receptor antagonist such as emesis, crebellar tremor, and appetite disorders (see the instant claim 1) comprising same compounds herein. Therefore, the teachings of Gold et al. would be inherent in the instant claimed methods See *Ex parte*

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Novitski 26 USPQ 2d 1389. Note that the amount of active compounds to be administered in instant invention is same as in Gold et al.

Even though Applicant's proposed amendment deleted "anxiety disorders, schizophrenia, drug and alcohol abuse disorders, depressive disorders, cognitive disorders, Alzheimer's disease" and "Parkinson's disease, Tourette's pain" from the original claims, the proposed amended claims are still seen to be anticipated by Gold et al. under the doctrine of inherency. See *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3d. 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001).

Therefore, Gold et al. anticipates the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
March 17, 2003